

indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the Examiner, the preambles of Claims 32 through 38 set forth a wheel, but the claims recite the combination of a wheel and an attached overlay, thereby making it indefinite as to whether the Applicant is claiming a wheel or a combination of a wheel and a cover.

The preambles to Claims 32 through 38 have been amended herein to clearly set forth that a wheel and overlay assembly are being claimed. Accordingly, the preambles of Claims 32 through 38 do particularly point out and distinctly claim the subject matter which Applicant regards as the invention and it is respectfully requested that the rejection of Claims 32 through 38 under 35 U.S.C. §112 be withdrawn.

In the above Office Action the Examiner provisionally rejected Claims 32 through 40 under 35 U.S.C. §101 as claiming the same invention as that of Claims 32 through 40 of copending application Serial No. 08/479,335. Since the conflicting claims have not been allowed, the double patenting rejection was provisional.

In response to the 35 U.S.C. §101 rejection, it is to be noted that significant statutory amendments were made in the Patent Statutes effective June 8, 1995, affecting the term of a patent. Accordingly, not because an Office Action was not issued in the current case prior to June 8, 1995, the undersigned filed a divisional application for the apparatus claims of the subject application until such time that an indication was received from the Examiner with respect to restriction of the claims set forth in the current application. Since a restriction requirement was not made in this application, and upon allowance of all of the claims in this application, the originally provided 17 year term will apply. The divisional application filed for Claims 32 through 40 will thus be allowed to lapse by failing to respond to the Office Action issued on September 26, 1995, Paper No. 4, in the copending application. Accordingly, it is

respectfully requested that the provisional double patenting rejection under 35 U.S.C. §101 with respect to Claims 32 through 40 be withdrawn for the reason that the copending application Serial No. 08/479,335 will be abandoned for failing to respond to the currently issued Action since a restriction requirement was not made in this application. Accordingly, upon allowance of all the claims remaining in the present application, copending application Serial No. 08/479,335 will be abandoned. Upon abandonment of the copending application, the issue with respect to double patenting will be moot.

The Examiner rejected independent Claims 1 and 8 under 35 U.S.C. §102(b) as being anticipated by Derleth. The Examiner further rejected independent Claims 32 through 38 as well as dependent Claims 34 through 36 under 35 U.S.C. 102(b) as being anticipated by Post et al as well as independent Claims 39 and 40 under 35 U.S.C. 102(b) as being anticipated by Derleth. With respect to Claims 1 and 8, it is the Examiner's conclusion that lines 43+ in column 3 of Derleth describe the temporary securing of the overlay to the wheel while the adhesive cures. Further, it is the Examiner's conclusion with respect to Claim 8 that the hubcap 21 and sleeve 18 assembly would form a fastener to help retain the overlay on the wheel. Accordingly, the Examiner considers both Claims 1 and 8 to be anticipated by the disclosure of Derleth. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claim 1 and dependent Claim 8 in view of the amendments presented herein and submitted herewith as well as the following argument.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. §102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents, functioning in substantially the same way to produce substantially the same results. As most recently noted by the Court of Appeals of the Federal Circuit in Lindemann Maschinenfabrick GmbH v.

American Hoist and Derrick, 221 U.S.P.Q. 481, 485 (1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. §102, the Court stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Applicant's amended independent Claim 1 require:

"A method for assembling an overlay to a wheel having a disk portion and a rim portion circumscribing said disk portion, said disk and rim portions defining an outboard surface of said wheel, said method comprising the steps of:

forming said overlay to have an inboard surface configured to face said outboard surface of said wheel upon assembling said overlay to said wheel;

providing a means, interposed said outboard surface of said wheel and said overlay, for temporarily securing said overlay to said outboard surface of said wheel and for positively positioning said overlay on said outboard surface of said wheel, said securing and positioning means causing said overlay to be centrally positioned with respect to said rim portion of said wheel and spaced from said outboard surface of said wheel so as to define at least one gap therebetween;

depositing a curable adhesive on at least one of said inboard and outboard surfaces...; and

temporarily securing said overlay to said outboard surface of said wheel with said securing and positioning means so as to positively position said overlay centrally relative to said rim portion of said wheel and so as to form said at least one gap therebetween, said curable adhesive filling at least a portion of said at least one gap, said securing and positioning means securing and positioning said overlay for a duration sufficient for said curable adhesive to permanently cure and thereby permanently secure said overlay to said wheel."

Applicant's dependent Claim 8 requires:

"The method of Claim 1 wherein said securing and positioning step comprises securing and positioning said overlay to said wheel with a fastener, said fastener constituting said securing and positioning means."

U.S. Patent 3,669,501 to Derleth does not have a step of providing a means, interposed the outboard surface of the wheel and the overlay, for temporarily securing the overlay to the outboard surface of the wheel and for positively positioning the overlay on the outboard surface of the wheel, the securing and positioning means causing the overlay to be centrally positioned with respect to the rim portion of the wheel and spaced from the outboard surface of the wheel so as to define at least one gap therebetween. Further, U.S. Patent 3,669,501 does not disclose the step of a temporary securing of the overlay to the outboard surface of the wheel with a securing and positioning means so as to positively position the overlay centrally relative to the rim portion of the wheel and so as to form the at least one gap therebetween.

Derleth does not disclose a step of providing a temporary positioning and securing means nor does Derleth have the step of temporarily securing and positioning the overlay to the outboard surface of the wheel so as to positively position the overlay centrally with respect to the rim portion of the wheel. Derleth does disclose at lines 43+ in column 3, that "Cover 14 is then immediately temporarily clamped onto the wheel so that it is positioned as shown in Fig. 2 with flanges 40 and 42 in seating contact, and with sleeve 18 inserted axially through hub portion 38 so that, as described previously, flange 36 seats against sleeve 18." Note carefully that Derleth's disclosure with respect to the temporary position is completely unenabling since not only is it not shown in the drawings, but it is not clear from the disclosure as to how the cover is clamped temporarily onto the wheel such that it is impossible to determine whether considerations are made with respect to positively locating the cover on the

wheel so as to centrally position the cover with respect to the rim portions of the wheel while the adhesive is curing. Further, the unenabling disclosure does not address that the means for temporarily securing and positioning the overlay are interposed the outboard surface of the wheel and the overlay.

Therefore, in applying the test for anticipation as set forth in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick*, supra, Derleth does not anticipate either independent Claim 1 or dependent Claim 8. Since Claim 8 is nothing more than a further delineation of the structure as set forth in independent Claim 1 from which it depends, Claim 8 must be read in light of the limitations set forth in independent Claim 1. From the above, it is clear that Derleth does not disclose the structure as set forth in independent Claim 1. Accordingly, withdrawal of the rejections of independent Claim 1 and dependent Claim 8 under 35 U.S.C. §102(b) is respectfully requested.

In the referenced Office Action the Examiner rejected independent Claims 32 and 38 and dependent Claims 34 through 36 under 35 U.S.C. §102(b) as being anticipated by Post et al. The test under 35 U.S.C. §102 is set forth above. Accordingly, Applicant's amended independent Claim 32 requires:

"A wheel and overlay assembly comprising:

a disk portion and a rim portion circumscribing said disk portion...;

an overlay juxtaposed said outboard surface of said wheel, said overlay having an inboard surface complementary to and facing said outboard surface of said wheel;

means interposed said inboard surface of said overlay and said outboard surface of said wheel for temporarily securing and for positively positioning said overlay on said outboard surface of said wheel, said securing and positioning means being attached to said inboard surface prior to securing and positioning said overlay on said wheel, and causing said

overlay to be centrally located with respect to said rim portion of said wheel and spaced from said outboard surface of said wheel so as to define at least one gap therebetween when said overlay is mounted on said wheel; and a permanent adhesive disposed in said at least one gap for permanently securing said overlay to said wheel."

Applicant's independent Claim 38, as amended, now requires:

"An automobile wheel and overlay assembly comprising:

a disk portion and a rim portion circumscribing said disk portion...;

a wheel bead seat formed on said rim portion, said wheel bead seat forming a peripheral surface feature on said outboard surface of said wheel;

an overlay juxtaposed said outboard surface of said wheel...;

a plurality of projections attached to and extending from said inboard surface of said overlay, each of said plurality of projections resiliently engaging said peripheral surface feature so as to secure said overlay to said wheel and positively position said overlay on said outboard surface of said wheel, said plurality of projections causing said overlay to be centrally located with respect to said rim portion of said wheel and spaced from said outboard surface of said wheel so as to define at least one gap therebetween; and

an adhesive disposed in said at least one gap for permanently securing said overlay to said wheel."

From the disclosure of Post et al, U.S. Patent 5,128,085, it is clear that Post et al does not have an overlay juxtaposed the outboard surface of said wheel. In fact, Post et al's overlay touches along boundaries for considerable distances and, accordingly, is contiguous the wheel rather than placed along side the wheel close together but not touching for considerable distances as required in Applicant's claim. Further, Post et al do not disclose means interposed the inboard surface of the overlay and the outboard surface of the wheel for temporarily securing

and positively positioning the overlay on the outboard surface of the wheel which means is attached to the inboard surface of the overlay. Further, the securing and positioning means is attached to the inboard surface prior to securing and positioning the overlay on the wheel which causes the overlay to be centrally located with respect to the rim portion of the wheel and spaced from the outboard surface of the wheel so as to define at least a gap therebetween when the overlay is mounted on the wheel. Post et al disclose, in Figures 8 through 10, a method of making a composite style wheel wherein the wheel itself is used as the upper cavity of the mold. A lower mold is used to temporarily nest a preformed mat-like core sheet 160 between the disc portion of the wheel and the lower mold. The preformed mat-like core sheet has a cross-sectional thickness corresponding to the minimum desired cross-sectional thickness dimension of the urethane outer portion 156 of the body 154. The mat 160 is adapted to be placed on a lower mold surface 230 in the mold open condition prior to seating of the disc and rim subassembly 24, 26, downwardly thereagainst. With the mold closed, a mold cavity 166 is defined between the inboard face 164 of the mat 160 and a portion of the juxtaposed outboard faces 46 and 48 of the disc and rim. With the mold apparatus in closed condition, a liquid reaction mixture is selected from a low density foam material and injected through a suitable pour opening provided in the disc into the "insert" mold cavity 166 so as to completely fill the same and thereby mold in-situ a weight-reducing insert 158 against the outboard faces 46 and 48 of the disc and rim. After such insert plastic material has cured sufficiently, the rim and disc subassembly 24 and 26 with insert 158 adhered thereto is lifted from the lower mold part. Through use of a suitable mold release coating agent, the insert 158 is readily stripped from the mat 160 during mold separation. Thereafter, the mat material 160 is stripped from the wheel subassembly after the same has been separated from the mold. At this point in the method of making the wheel the die mold components are again put together with the mat 160 absent from the mold in

order to provide a mold cavity 170 between the upper face 230 of the lower mold part 200 and the juxtaposed outboard face 172 of insert 158, as well as between the outboard surfaces of disc 24 and rim 26 not covered by insert 158. A second mold filling injection step is then performed, via a suitable second pour opening provided in the disc communicating with cavity 170, to thereby fill cavity 170 with the liquid urethane reaction mixture of a low density nature so as to completely fill the cavity space 170 to thereby form the urethane outer facing 156 of the overlay 154. After this material has cured sufficiently for mold separation, the upper clamp is removed and the finished wheel 150 lifted from the lower mold.

Note specifically that Post et al completely fail to disclose in any way whatsoever any means interposed the inboard surface of the overlay and the outboard surface of the wheel for temporarily and positively positioning the overlay which is attached to the inboard surface of the overlay prior to securing and positioning the overlay on the wheel. Further, Post et al is completely devoid of any disclosure with respect to the method of making the composite-styled wheel causing the overlay to be centrally located with respect to the rim portion of the wheel. Accordingly, in applying the test of *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick*, supra, Post et al do not anticipate independent Claims 32 and 38. Accordingly, withdrawal of the rejection of independent Claims 32 and 38 under 35 U.S.C. §102 is respectfully requested. Further, since dependent Claims 34 through 36 are but further delineations of the structure claimed in independent Claims 32 and 38, it is respectfully suggested that such claims are also not anticipated by the disclosure of Post et al in that dependent claims must be read in light of the structure set forth in the independent claim from which they depend. It is therefore respectfully requested that the rejections of Claims 32 through 36 and 38 be withdrawn with respect to 35 U.S.C. §102(b).

Finally, the Examiner rejected independent Claims 39 and 40 under 35 U.S.C. 102(b) as anticipated by Derleth. Again, Applicant's attorney

respectfully traverses the Examiner's rejection of independent Claims 39 and 40 in view of the following. The test under 35 U.S.C. 102 is set forth above.

Accordingly, Applicant's amended independent Claim 39 requires:

"An overlay for a wheel and overlay assembly having an outer surface and an axis, said overlay comprising:

an ornamental panel member having a substantially uniform thickness; a first surface; and an oppositely disposed second surface;

a decorative layer adhered to said first surface of said ornamental panel member;

means interposed said second surface of said ornamental panel member and said outer surface of said wheel for temporarily securing and positioning said ornamental panel member on said wheel, said securing and positioning means being attached to said second surface of said ornamental panel member and causing said ornamental panel member to be centrally mounted with respect to said rim portion of said wheel and spaced from said outboard surface of said wheel so as to define at least one gap therebetween; and

adhesive means selectively positioned between said second surface of said ornamental panel member and said outer surface of said wheel, said adhesive means permanently attaching said overlay directly to said outer surface of said wheel;

whereby said decorative layer of said first surface substantially covers said outer surface of said wheel."

Accordingly, Applicant's amended independent Claim 40 requires:

"In a composite vehicle wheel having a wheel with a web portion and a rim portion circumscribing said web portion, said web portion defining an outboard surface of said composite vehicle wheel, an ornamental panel member attached to said outboard surface of said web portion, said ornamental panel member having a first surface and an oppositely disposed second surface:

adhesive means selectively positioned between said ornamental panel member and said outboard surface of said wheel, said adhesive means temporarily and permanently attaching said overlay directly to said outboard surface of said wheel;

a decorative layer adhered to said first surface of said ornamental panel member;

said ornamental panel member being a thin panel of substantially uniform thickness; and

means for temporarily and permanently securing and positioning said ornamental panel member on said wheel, said securing and positioning means interposed said ornamental panel member and said outboard surface and causing said ornamental panel member to be centrally mounted with respect to said rim portion of said wheel and spaced from said outboard surface of said wheel so as to define at least one gap therebetween;

whereby when said ornamental panel member is directly attached to said outboard surface of said wheel by said adhesive means said decorative layer of said first surface substantially covers said outboard surface of said wheel."

U.S. Patent 3,669,501 to Derleth does not have a step of providing a means, interposed the outboard surface of the wheel and the overlay, for temporarily securing the overlay to the outboard surface of the wheel and for positively positioning the overlay on the outboard surface of the wheel, the securing and positioning means causing the overlay to be centrally positioned with respect to the rim portion of the wheel and spaced from the outboard surface of the wheel so as to define at least one gap therebetween. Further, U.S. Patent 3,669,501 does not disclose the step of a temporary securing of the overlay to the outboard surface of the wheel with a securing and positioning means so as to positively position the overlay centrally relative to the rim portion of the wheel and so as to form the at least one gap therebetween.

Derleth does not disclose a step of providing a temporary positioning and securing means nor does Derleth have the step of temporarily securing and positioning the overlay to the outboard surface of the wheel so as to positively position the overlay centrally with respect to the rim portion of the wheel. Derleth does disclose at lines 43+ in column 3, that "Cover 14 is then immediately temporarily clamped onto the wheel so that it is positioned as shown in Fig. 2 with flanges 40 and 42 in seating contact, and with sleeve 18 inserted axially through hub portion 38 so that, as described previously, flange 36 seats against sleeve 18." Note carefully that Derleth's disclosure with respect to the temporary position is completely unenabling since not only is it not shown in the drawings, but it is not clear from the disclosure as to how the cover is clamped temporarily onto the wheel such that it is impossible to determine whether considerations are made with respect to positively locating the cover on the wheel so as to centrally position the cover with respect to the rim portions of the wheel while the adhesive is curing. Further, the unenabling disclosure does not address that the means for temporarily securing and positioning the overlay are interposed the outboard surface of the wheel and the overlay.

Therefore, in applying the test for anticipation as set forth in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick*, supra, Derleth cannot anticipate either independent Claims 39 or 40.

Accordingly, withdrawal of the rejection of independent Claims 39 and 40 as amended, under 35 U.S.C. 102(b) is respectfully requested.

The Examiner rejected Claim 33 under 35 U.S.C. §103 as being unpatentable over Post et al and Claim 37 under 35 U.S.C. §103 as being unpatentable over Post et al in view of Beam, as well as Claims 39 and 40 under 35 U.S.C. §103 as being unpatentable over Post et al in view of Derleth. Applicant's attorney respectfully traverses each of the 35 U.S.C. §103 rejections set forth in view of the claims as amended and for the

reason that Applicant's invention is not an obvious improvement over the prior art.

With respect to the rejections under 35 U.S.C. §103, it is noted in MPEP Section 706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in *Graham v. John Deere*, 148 U.S.P.Q. 459 (1966), where the Court stated:

"Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

Accordingly, to establish a prima facie case of obviousness, the Patent Office must: (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a motivating suggestion, inference or implication to make the modifications proposed in step (2). *In Re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

The mere fact that the prior art may be modified by the Examiner does not make the modification obvious unless the prior art suggests the desirability for the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In the present case, the Examiner has failed to make a proper prima facie showing of obviousness since the Examiner has failed to show how the prior art suggests the desirability of the proposed modification.

Post et al, U.S. Patent 5,128,085, is directed to the problems associated with prior art POLYCAST wheels wherein a single cavity established between the wheel and a lower mold receives a urethane foam which has a constant density throughout. Accordingly, because of the single mold cavity, it is not possible to reduce the density of the foam and

thereby lighten the composite wheel and overlay assembly since the constant density throughout is required by the application.

Accordingly, Post et al's solution to this problem is provided by a method of in-situ molding by first establishing a cavity with a liner to insert a polyurethane foam having a low density mixture and then allowing the foam to set. After the foam has hardened, the mold is opened, the liner is removed from between the lower mold and upper mold portion of the wheel, and reclosed to provide a cavity which allows an outer layer urethane elastomeric material of a higher density to be molded in the area where the liner was located and thereby provide the appropriate density outer surface with a low density or lighter material filling the majority of the void between the decorative outer layer and the wheel surface in order to reduce the weight of the overall assembly.

Derleth, U.S. Patent 3,669,501, is the prior art that Post et al is referring to which provides an in-situ mold to make an adhesive foam body wheel cover and overlay assembly. Derleth is directed to the problems associated with the application of an adhesive foam body wheel cover to the outboard side of the wheel in order to reduce noise.

Derleth teaches the application of an ornamental plastic cover secured by an adhesive foam body to create an aesthetically pleasing appearance and improve anti-noise characteristics in the wheel cover and wheel combination structure. An ornamental cover 14 preferably made of a readily formable thermo-plastic material such as ABS is permanently bonded to the wheel by a body 16 of adhesive material such as polyurethane foam disposed in the space between the cover 14 and the outboard faces of the disc 12 and rim 10. In addition to serving as an adhesive, the body 16 of the foam filling provides a low density, semi-resilient reinforcement for the thin gauge cover 14. Preferably the cover is made of a high impact, resilient plastic material such as acrylonitrile-butadiene-styrene polymers, commonly referred to as an ABS polymer. Preferably, the cover 14 is chrome

plated on the outboard or exterior side thereof by a known plastic chrome plating process. Derleth also teaches that the inboard and outboard surfaces of the plastic portion comprising the body of plastic material are spaced from one another axially such that the distance between the inboard and outboard surfaces axially of the wheel vary in a direction transverse to the wheel such that the outboard surface has a three-dimensional contour differing from that of the inboard surface of the wheel and is adapted to provide a decorative contour exposed to view on the outboard side of the wheel. Accordingly, Derleth teaches that the outer contour of the overlay is different than the face or side of the wheel.

Beam, U.S. Patent 5,368,370, is directed to the high cost of chrome plating aluminum wheels over the wheels having a nonchrome plate finish.

Beam teaches a composite vehicle wheel assembly having a permanent ornamental surface treatment. The assembly consists of an annular rim and a spider concentrically fixed within the rim for connecting to a rotating hub. A steel ornamental applique of uniform material thickness overlaps the rim and the spider. The steel applique has an annular outer connecting portion disposed adjacent one of the rim flanges and an innerconnecting portion and a plurality of vent openings aligned between the spokes of the spider and located between the inner and outer connecting portions. Beam teaches that the mechanical connection established between the outer and inner connecting portion is relied upon in order to establish temporary location of the overlay with respect to the wheel to compress the adhesive before it cures. The outer connecting portion is an interlock of the cover with an undercut 46 in the rim to hold the applique in place. The inner connecting portion is deforming a section of the metal disc as shown at 50 into the hole in the center section of the spider in order to provide an interlock at the innerconnecting portion.

The differences between Applicant's invention and the prior art references cited by the Examiner in the rejection under 35 U.S.C. §103 are

quite clear. The solution taught by each of the references is directed to problems totally different than that described in Applicant's invention. For example, Derleth is directed to the problems associated with noise between a wheel cover and a wheel, while Post et al is directed to the problems of the density of a polyurethane cast wheel wherein the prior art method of making the wheel requires the use of a single molded insert of consistent density thereby preventing the use of a lower density material in order to lighten the assembly. Beam is directed to the high cost of chrome plating mag wheels and the inapplicability of using either the Derleth or prior polyfoam designs as a result of chipping of the chrome from the polycast urethane plastic.

Applicant's invention is directed to the problem of positioning the overlay with respect to the rim without the use of interlocks such as Beam since these cause galvanic action between the overlay and the wheel rim and require additional manufacturing of the wheel rim in order to maintain the interlocking arrangement. Accordingly, Applicant teaches an overlay which is attached to the inboard side and includes securing and positioning means to accurately maintain the position of the overlay with respect to the wheel rim while the adhesive cures and further improves the overall manufacturability, performance and consumer perceived quality of the overlay and wheel assembly.

If, as the Examiner suggests, the teachings of Post et al are combined with either the teachings of Beam or Derleth, it is clear from the teachings set forth in these references that the suggested combination would not result in Applicant's invention and would in fact require extensive additional structure in an attempt to acquire similar results. Even if such combination was accomplished, it must be pointed out that if Post et al is combined with either the teachings of Beam or Derleth, the suggested combination would not result in Applicant's invention and would, in fact, require the addition of some positioning means attached to the inboard

surface of the overlay in order to centrally locate the overlay with respect to the wheel rim while the adhesive is permanently curing. Further, especially combining the teachings of Post et al with Beam would still result in the unacceptable galvanic action which occurs between the overlay and the wheel rim as a result of the outerconnecting portion as taught by Beam. Also, even if combining Post et al with Beam, the high temperature experienced under certain driving and testing conditions detrimentally affects the full surface urethane layer of the curable adhesive taught by Post et al. Also, combining the teachings of Post et al with the teachings of Beam would result in a polyurethane cover as suggested by Post et al covered with a metal cover as suggested by Beam using the interlock between the periphery of the metal cover and the wheel rim on the outermost portions as well as the lock of the innerconnecting portion 50 in order to establish location with respect to the wheel. Certainly, such combination would be extremely expensive and would destroy the objectives of Post et al. The combined resulting structure would be more cumbersome, require a significant amount of additional space, as well as be incompatible with the teachings of Post et al. Even if accomplished, it appears from the teachings of Post et al that the combined structure would be inoperative in that there is no teaching whatsoever with respect to how to establish the interlock at the outer rim of the wheel after Post et al has completely filled this area with its foam urethane rubber.

In any event, even if, as the Examiner suggests, the teachings are combined, one skilled in the art would have no basis for making such a combination of Post et al and either Beam or Derleth, since none of the references are directed to problems solved by Applicant's invention nor is Post et al, Beam or Derleth directed to teaching a wheel and overlay assembly that provides means interposed the inboard surface of the overlay in the outboard surface of the wheel for securing and positioning the wheel during curing of the adhesive in order to centralize the wheel cover with

respect to the wheel rim. Thus, it is respectfully suggested that, but for the disclosure made by the Applicant in the application, there is no suggestion whatsoever to combine Post et al's teachings with either Beam or Derleth in order to obviate Applicant's invention as taught by the claims presently pending in the application. Thus, it is only through Applicant's teachings and disclosure that one of ordinary skill in the art would appreciate the need for providing a combination securing and positioning means on the back side of an overlay in order to centralize the cover to the wheel during the curing of the permanent adhesive. In view of this, a person of ordinary skill in the art would not seek to combine these references cited by the Examiner to produce the results that Applicant's invention as claimed now teaches.

It is well settled patent law that the mere fact that a disclosure can somehow be combined with other references does not make that combination obvious unless the prior art contains some suggestion of the desirability for combining the prior art references. Here, the prior art contains absolutely no suggestion whatsoever for combining the references as set forth in the Examiner's rejection to teach the invention as claimed according to Applicant's disclosure. Therefore, it is respectfully suggested that the Examiner is using hindsight reconstruction in an attempt to obviate Applicant's invention after having had the benefit of reading Applicant's application. Absent recognition of the problem faced by the Applicant, how can the prior art possibly suggest singularly or in combination a solution as novel as Applicant's invention. Accordingly, Applicant's invention is indeed an unobvious improvement over the art of record and not an obvious modification of any of the references cited by the Examiner. When viewed singularly or collectively, none of the prior art references teach an overlay assembly wherein means are provided on the inboard surface of the overlay for centralizing the overlay with respect to the wheel rim during the time that the permanent adhesive cures.

In view of the foregoing remarks, the undersigned attorney respectfully submits that the amended independent claims as well as the dependent claims are clearly allowable. Therefore, Applicant's attorney respectfully requests that the Examiner's rejections under 35 U.S.C. §103 be withdrawn from the claims as amended herein and that a formal Notice of Allowance be issued therefor.

The Examiner indicated that Claims 2 through 7 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form to include all limitations of the base claim and any intervening claims. Further, the Examiner considers Claims 9 through 31 as allowable over the prior art of record. Claims 2 through 7 were not rewritten in independent form for the reasons that the independent claims as amended in the application are clearly patentable over the teachings of the prior art and are not anticipated by any of the prior art. Accordingly, it is believed that the amended independent claims as now pending in the application are allowable.

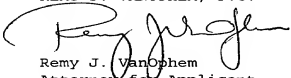
For the convenience of the Examiner a copy of the claims as currently pending in the application, omitting all bracketed text and underlining is included herewith as Exhibit A.

If the Examiner has any questions with respect to any matter now of record, Applicant's attorney may be reached at (810) 362-1210.

755 W. Big Beaver Rd.
Suite 1313
Troy, MI 48084
(810) 362-1210
Attorney Docket: LIII126A US
RJV/cam

Respectfully submitted,

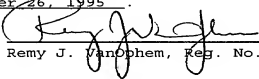
REMY J. VANOPHEM, P.C.


Remy J. VanOpheem
Attorney for Applicant
Registration No. 27053

Certificate Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box Non-Fee Amendment, Washington, D.C. 20231, on December 26, 1995.

Date: December 26, 1995


Remy J. VanOpheem, Reg. No. 27053